



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,368	04/20/2004	Shiv Kumar Agarwal	115683.01	3821
25944 7590 03/12/2007 OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER RAO, DEEPAK R	
			ART UNIT	PAPER NUMBER
			1624	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/12/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/827,368

Applicant(s)

AGARWAL ET AL.

Examiner

Deepak Rao

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 are pending in the application.
- 4a) Of the above claim(s) 4-13 and 18-36 are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,14 and 15 are rejected.
- 7) ☒ Claim(s) 3,16 and 17 are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/409,045.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claims 1-36 are pending in this application.

Election/Restrictions

Claims 4-13 and 18-36 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 21, 2006.

Applicant's submission that 'claims 4-8 and 18-36 directed to the process of making and using the pyrimidone compounds of formula (I) should be rejoined' is acknowledged. As indicated in the previous office action, **process claims that depend from or otherwise include all the limitations of the patentable product** will be considered for rejoinder, when the product claim is found to be allowable.

It is maintained that claims 9-13 are drawn to structurally different compounds and/or processes thereof and the restriction requirement thereof is maintained.

The restriction requirement is still deemed proper and is therefore made FINAL.

The search and examination of the application was based on the elected species of Example 10 and the claims were searched to the extent readable on the subgenus of formula (I) wherein: X is O, R⁶ is CN; the rings A and B are phenyl; and R¹-R⁵ are as defined in the claims.

Applicant's amendment overcomes the art rejections of the previous office action. As per the guidelines of MPEP § 803.02, the search is expanded to the subgenus of formula (I) wherein:

Art Unit: 1624

X is O; the rings A and B are phenyl; and R¹-R⁶ are as defined in the claims, and art was found.

As per the guidelines of MPEP § 803.02, the Markush-type claims were examined to the extent of the searched subgenus. The generic subject matter (i.e., all other definitions of X, and rings A and B) drawn to the non elected species from claims 1-2 and 14-15; and the species of claims 3 and 16-17 having substituents other than as indicated above are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected species.

Withdrawn Rejections/Objections:

Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

The following rejections are necessitated by the amendment:

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-2 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sharma et al., CAPLUS Abstract 123:313866 (1995). The instant claims read on reference disclosed compound, see the compound RN 170311-67-8 in the enclosed copy of CAPLUS computer search report (page 117).

Art Unit: 1624

2. Claims 1-2 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Mazumdar et al., CAPLUS Abstract 121:157595 (1994). The instant claims read on reference disclosed compounds, see the compounds having RN 157333-51-2; 157333-52-3; 157333-53-4; 157333-54-5; 157333-55-6; 157333-56-7; 157333-57-8; and 157333-58-9 in the enclosed copy of CAPLUS computer search report (pages 125-127).

Allowable Subject Matter

Claims 3, 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable to the extent readable (**on the expanded subgenus as indicated above, i.e., X is O and rings A and B are phenyl**) if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1624


however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deepak Rao
Primary Examiner
Art Unit 1624

March 5, 2007